

REMARKS

Claims 1-13 are pending and 1-13 are rejected.

35 USC 103(a)

Claims 1-13 are rejected under 35 USC 103(a) as being unpatentable over Aho US 6,531,196.

Examiner alleges Aho '196 teaches that it is known in the art to make and use composition comprising the claimed elements to coat a paper. Examiner further alleges that the applied reference does not specifically teach the imide component, however he states imides are well known in such compositions and are known to improve barrier properties. Thus, he further reasons the addition of the imide component would be obvious to anyone skilled in the art.

The Applicants respectfully believe the above rejection to be highly improper for several reasons.

The Patent Office Patent Examiner Initial Training Manual reads:

Chapter 8, pages 8-9 (Revised February 8, 2001)

Rejections under 35 U.S.C. 103(a) require that the factual basis for the rejection be effectively communicated in the written action. Office policy is that each rejection under 35 U.S.C. 103(a) must communicate in writing

1. what the primary reference teaches relative to the claimed invention,
2. the differences between the claimed invention and the primary reference,
3. what the secondary references teach relative to the differences,
4. how the primary reference is to be modified by the secondary references to arrive at the claimed invention, and,
5. an explanation of why the proposed modification or combination would have been suggested by the prior art.

The Applicants believe the Examiner has not met his burden of establishing the factual basis for his 103(a) rejection based on Aho for the reasons listed below:

1. Examiner has referred to the abstract and column 3, lines 1-40 of Aho and alleged that the claimed elements to coat a paper are taught. The Applicants once again respectfully disagree.

The present claim 1 requires:

- (A) 5 to 89 wt. % of polyvinyl butyral
- (B) 1 to 20 wt. % of styrene maleic imide and
- (C) 5 to 50 wt. % of ethylene acrylate.

Not one of the required limitations of the coating (A thru C) is disclosed or suggested in Aho.

The Applicants direct the Examiner to the disclosure in column 3, lines 1-17.

Polymers suitable for the polymer basis of a coat according to the invention for a board include styrene butadiene, styrene acrylate, acrylate or vinyl acetate polymers and copolymers, or blends of these. The polymer may be prepared by using a monomer blend containing as its principal components vinyl acetate and a (methyl, ethyl, propyl or butyl) ester of acrylic acid and/or methacrylic acid and/or lower alcohols, or by using a monomer blend containing as its principal components styrene and a (methyl, ethyl, propyl or butyl) ester of acrylic acid and/or methacrylic acid and/or lower alcohols or by using a monomer blend containing as its principal components a (methyl, ethyl, propyl or butyl) ester of acrylic acid and/or methacrylic acid and/or lower alcohols and/or a copolymer of these.

The claimed composition of the invention **does not appear anywhere in the above** (components (A) thru (C) at the various ranges). Only styrene butadiene is exemplified and this is an optional component of the present claims. As the Examiner is aware, an obvious rejection requires all elements of the claims be present. This is not the case. Thus there is in fact no basis for the rejection.

The examiner has not explained why the Aho reference would have fairly suggested, to one of ordinary skill in the art, the use of components (A) through (C) on paper when Aho does not mention or suggest anyone of components (A) through (C).

2. The stated differences alleged by the Examiner are the imide component and the claimed ranges. However, the Examiner believes the incorporation of such a component at the claimed ranges to be obvious as it is known that imides improve barrier properties. This statement must be backed by fact not speculation.

As stated *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967), **cert. denied**, 389 U.S. 1057 (1968)

The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.

3. The Examiner has provided no secondary references to back his statements that the imide component and the claimed ranges are obvious to one having ordinary skill in the art.

Instead, the Examiner has made the statement that imides are well known in such compositions and improve barrier properties. This may or may not be true.

The problem with the statement by the Examiner that "this is well known", is that the statement is not backed up by factual information either in the prior art (Aho) or any other cited prior art.

Furthermore, the Examiner has used a primary reference which does not even suggest components (A and C) of the present invention. The Examiner then states that the combination of the imide component (also not suggested in Aho) is obvious because imides are well known for their barrier properties. The Applicants find this reasoning completely unsupported by any factual basis. Moreover, the addition of a specific imide (styrene maleic imide) to components not disclosed or suggested in Aho cannot be obvious even if the Examiner's statement "that imides are known to improve barrier properties" is true. The required elements A and C are still missing. Thus one does not arrive at the presently claimed invention even if imides are well known as barrier improvers for paper.

Additionally, the Examiner's statement that ranges are "obvious" to the art skilled is unreasonable particularly when the components are not suggested or disclosed by Aho ((A) thru (C)).

Thus the Applicants believe the Examiner's has made no factual basis for his rejection as to any one of the presently claimed elements or ranges.

The 103 (a) rejection is thus completely improper for the reasons given above.

Reconsideration and withdrawal of the rejection of claims 1-13 is respectfully solicited in light of the remarks *supra*.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 1-13 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



Shiela A. Loggins
Agent for Applicants
Reg. No. 56,221

Ciba Specialty Chemicals Corporation
540 White Plains Road
Tarrytown, New York 10591
(914) 785-2768
SAL23158FR.doc